

REMARKS

In the Office Action, claims 21-24 were rejected. More specifically,

- Claim 24 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite;
- Claims 21-24 were rejected under 35 U.S.C. §112, first paragraph, as non-enabling;
- Claims 21-24 also were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious in view of the publication titled "Glucose oxidase as the antifungal principle of *Talaromyces flavus*" (Kim); and
- Claims 21-24 also were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious in view of the publication titled "Biological Control of Verticillium Wilt of Eggplant in the Field" (Marois).

By this Amendment, claim 24 has been amended. Upon entry of this Amendment, claims 21-31 are pending, of which claims 25-31 are withdrawn. For the reasons set forth hereinbelow, Applicants traverse the rejections and respectfully request that the rejections of the claims be withdrawn.

§112 Rejections (Second Paragraph)

Claim 24

Applicant submits that the amendment of claim 24 renders the present rejection under 35 U.S.C. § 112, ¶2 moot. Withdrawal of the present rejection is respectfully requested.

§112 Rejections (First Paragraph)

Claims 21-24

Applicants respectfully note that the present specification has been amended herein to address the Examiner's concerns. The specification has been amended to refer to the deposit by deposition number, date of deposit, name and address of the depository, and complete taxonomic description. Furthermore, Applicants submit herewith a "Statement of Biological Culture Deposit" averring the same. MPEP § 2410.02. It is respectfully submitted that the amendment and statement address the present rejection. Therefore, Applicants request the withdrawal of the present rejection of claims 21-24 under 35 U.S.C. § 112, ¶1.

§102/103 Rejections Based on Kim

Claims 21-24

The Examiner rejects claims 21-24 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kim et al., of record. It is respectfully submitted that the Examiner has inappropriately assumed that the strains disclosed in Kim et al. are inherently the same as those disclosed and claimed in the present application. In addition, the strains disclosed and claimed in the present application display unexpected properties when compared to those strains disclosed in Kim et al.

Applicants draw the Examiner's attention the "Declaration Of Hideaki Tateishi Under 37 C.F.R. § 1.132" submitted herewith. In that declaration, experiments comparing *Talaromyces flavus* of Kim (ATCC32098) and the presently claimed *Talaromyces sp. B-422* on the efficacy to "Bakanae" disease caused by *Gibberella fujikuroi* and to rice seedling rot caused by *Burkholderia glumae*. The result indicates that *Talaromyces flavus* of Kim show no effect while *Talaromyces sp. B-422* was effective in treating that disease. Those results demonstrate that the

presently claimed strain is not inherently the same as the *Talaromyces flavus* strain of Kim (ATCC32098) and the rejection under 35 U.S.C. § 102(b) is thus inappropriate.

Those same results also demonstrate that the presently claimed strain displays the unexpected result of improved efficacy in treating “Bakanae” disease caused by *Gibberella fujikuroi* and to rice seedling rot caused by *Burkholderia glumae*. Objective evidence and secondary considerations such as unexpected results, commercial success, long felt need, failure of others, copying by others, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP § 2141.01. In the present circumstances, the attached Declaration clearly demonstrates such unexpected results. It is respectfully submitted that in light of those data, the present obviousness rejection is untenable and should be withdrawn. Reconsideration of this obviousness rejection is respectfully requested.

Therefore, Applicants submit that claim 21 is nonobvious in view of Kim. Applicants further submit that claims 22-24, which depend from claim 21, are also nonobvious in view of Kim. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious).

In view of the foregoing, Applicants respectfully request that the §102 and §103 rejections based on Kim be withdrawn.

§102/103 Rejections Based on Marois

Claims 21-24

The Examiner rejects claims 21-24 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Marois et al., of record. It is respectfully submitted that the Examiner has inappropriately assumed that the strains disclosed in Marois et

al. are inherently the same as those disclosed and claimed in the present application.

Additionally, the presently claimed strain displays unexpected properties when compared to Marois et al. and is thus non-obvious over Marois et al.

Maroris et al. discloses that *Talaromyces flavus* is parasitic on *Rhizoctonia solani* Kuhn, but does not teach or suggest that *Talaromyces flavus* is active to *Gibberella fujikuroi* or *Burkholderia plantarii*. It is clear that *Talaromyces sp. B-422* of the present claims is different from *Talaromyces flavus* disclosed in Marois et al. Those differences alone establish that the strain disclosed in Marois et al. is not inherently the same as the presently claimed strain and, thus the rejection under 35 U.S.C. § 102(b) is thus inappropriate.

With respect to the §103 rejections, Applicants submit that independent claim 21 is nonobvious in view of Marois. In accordance with the analysis stated in *Graham v. John Deere Co.*, a determination of obviousness under § 103 requires (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The question of obviousness must be resolved on the basis of these factual inquiries and any secondary considerations. *See* MPEP § 2141.

Applicants submit that the differences between the Marois et al. and the claimed invention are **substantial**, and that when the invention recited in claim 21 is considered as a whole, the invention recited in claim 21 is nonobvious in view of Marois et al.. *See* MPEP § 2141.02. The fact that Marois fails to disclose, teach or suggest a strain of *Talaromyces flavus* that is active to *Gibberella fujikuroi* or *Burkholderia plantarii*, as displayed by the presently claimed strains, supports a finding that claim 21 is nonobvious in view of Marois et al..

Therefore, Applicants submit that claim 21 is nonobvious in view of Marois et al. Applicants further submit that claims 22-24, which depend from claim 21, are also nonobvious in

view of Marois et al. *See* MPEP §2143.03.

In view of the foregoing, Applicants respectfully request that the §102 and §103 rejections based on Marois et al. be withdrawn.

CONCLUSION

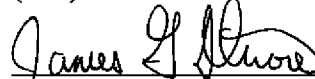
Applicants respectfully request a Notice of Allowance for the pending claims in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 23, 2010

Robert A. Muha
Registration No. 44,249

Reed Smith LLP
P.O. Box 488
Pittsburgh, PA 15230
(412) 288-7222



James G. Dilmore
Reg. No. 51,618

Reed Smith LLP
P.O. Box 488
Pittsburgh, PA 15230
(412) 288-3813